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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/036,825 | 11/08/2001 | Jerome C. Bertrand | CW-06562 | 6104 |

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09/03/2003

Christine A. Lckutis
MELDEN & CARROLL, LLP
Suite 350
101 Howard Street
San Francisco, CA 94105

EXAMINER

TOOMER, CEPHIA D

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,825

Applicant(s)

BERTRAND ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to the amendment filed June 12, 2003 in which claims 2-6, 9, 11, 16, 18, 22, 24 and 29 were amended; claims 30-32 were canceled and claims 12 and 33-34 were added. Since claim 12 has now been added, all claims have been renumbered according to 35 CFR 1.126. In future correspondence with the Office please refer to the claims as follows:

- Claims 1-11 are numbered as originally filed;
- Claim 12 is claim 34
- Claims 13-29 are now claims 12-28 and;
- Claims 33 and 34 are now claims 32 and 33. The dependence of the claims have been amended accordingly.

2. The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendments to the claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. There is no support in the original filed application for the limitation of "wherein said fatty alcohol comprises at least 25% by weight of said composition". The language at least 25% encompasses proportions that are not present in the specification. The examples of Table V include various proportions for the fatty alcohol, but does not include 26% or 40% or 48% or 58%. All of these percentages would be examples that are encompassed by "at least 25%".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 23, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Octadecanol (stearyl alcohol).

Octadecanol is a C₁₈ fatty alcohol having a melting point of 61° C (141.8° F).

Accordingly, octadecanol meeting all the limitations of the claims, anticipates the claims.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-27 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pungs (US 1,950,814) in view of Egan (US 1,935,946).

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Pungs teaches a candle composition comprising free fatty alcohols that are prepared from montan waxes or vegetables. The alcohols have 14 or more carbon atoms and a melting point of above 45° C. The alcohol is present in the candle composition in an amount from 1.5 to 20% (see lines 1-54). The candle base material may be paraffin wax, stearine, stearic acid or synthetic fatty acids and mixtures thereof (see lines 55-68). Pungs teaches that the candles have non-smoky flames (see lines 84-88). Pungs teaches the limitations of the claims other than the differences that are discussed below.

Pungs fails to teach the claimed IV; however, it would have been obvious to one of ordinary skill in the art to have prepared the composition possessing the claimed IV because Pungs teaches saturated fatty alcohols in combination with paraffin wax and/or stearic acid or stearine (saturated compounds).

Pungs differs from the claims in that he does not teach hydrogenated free fatty acids. However, Egan teaches this difference.

Egan teaches a candle composition wherein natural oils are hydrogenated to an IV of 5 or lower and separates the fatty acid from the oil (see lines 1-15, 33-54).

It would have been obvious to one of ordinary skill in the art to have substituted hydrogenated stearic acid for stearic acid because Egan teaches that hydrogenated stearic acid allows the candle maker to use less refined paraffin wax (see lines 28-41) and because he teaches that they are art recognized equivalents.

9. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the claims are allowable since some of the claims have been amended to include at least 25% of the alcohol and at least 1 % of the paraffin.

The examiner respectfully disagrees. Pungs teaches that the candle composition contains up to 20 % of the fatty alcohol, and it is well settled that a prima facie case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

With respect to the amount of wax, the composition of Pungs is not limited to a major amount of wax. Given that he teaches that a mixture of the non-fibrous combustible substances may be used, one of the other components may be present in a major amount.

With respect to the Iodine value, it is clear that the composition of Pungs suggests it. Pungs does not recite the use of any unsaturated compounds. Therefore, it would be reasonable to expect that the Iodine Value of the composition would fall within the claimed Iodine value range. Applicant's data have been considered regarding the Iodine value; however, since Applicant does not disclose which compounds are used to prepare the compositions, it cannot be ascertained if the compositions contain all saturated fatty acids, alcohols and triglycerides.

Applicant argues that there is no suggestion or motivation to combine Pungs and Egan especially in claims that do not contain paraffin.

Egan does teach that the hydrogenated fatty acid is used in candle making in order to prepare candles using less refined paraffin wax. However, Egan also teaches

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that it was known before the time of his invention that the hydrogenated fatty acids could be substituted for commercial stearic acid. Therefore, it would have been obvious to one of ordinary skill in the art to have substituted the hydrogenated fatty acid for the commercial fatty acid of Pungs because they are art-recognized equivalents.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Cephia D. Toomer
Primary Examiner
Art Unit 1714

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